

### REMARKS

In response to the non-final Office Action mailed October 30, 2003, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

In the Office Action, claims 1-25 were rejected. More specifically,

- Claims 1-4, 7, 9-10, 14-18 and 25 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 6,259,405 (Stewart) in view of U.S. Patent 6,522,876 (Weiland);
- Claims 5-6, 8, 11-12 and 19-23 are rejected under 35 U.S.C. § 103(a) as being obvious over Stewart in view of Weiland and U.S. Patent 6,484,148 (Boyd); and
- Claims 13 and 24 are rejected under 35 U.S.C. § 103(a) as being obvious over Stewart in view of Weiland and U.S. Patent 5,852,775 (Hidary).

For the reasons set forth hereinbelow, Applicants respectfully request that the rejections associated with the pending claims be withdrawn.

#### Claims 1-4, 7, 9-10 and 14-15

**First**, Applicants submit that independent claim 1 is nonobvious over Stewart in view of Weiland because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 1. *See* MPEP § 2143 (stating that one of the elements of a *prima facie* case of obviousness under § 103(a) is that the cited references must teach or suggest every limitation of the claimed invention). More specifically, Applicants submit that the cited references fail to disclose, teach or suggest, among other things, “transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party” as recited in claim 1.

In contrast to the invention recited in claim 1, Applicants submit that Stewart teaches a portable computing device 110 in communication with an access point 120 that is coupled to one or more service providers 140 via a centralized network 130. The portable computing device 110 transmits a signal that is detected by the access point 120. The signal indicates the presence of the portable computing device 110 as well as identification information indicating the mobile user of the portable computing device 110. *See* Stewart, column 2, lines 50-56. In addition, Applicants note that Stewart, at column 2, lines 62-65, discloses that the access point transmits the identification information to one or more of the service providers 140. Thus, Applicants agree with the Examiner's determination that Stewart does not teach "transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party" (referred to in the Office Action as an identity-blocking service) as recited in claim 1.

With respect to Weiland, Applicants submit that Weiland teaches a central control point (i.e., service control point) that receives a profile management code (i.e., feature code) and responsively performs an action that corresponds to the profile management code. Applicants further submit that Weiland, at column 7, lines 49-51 thereof, merely teaches a feature code which indicates that the action to be performed by the central control point for a particular subscriber is blocking the calling-number identification information of the subscriber for a subsequently dialed call (i.e., preventing the subscriber's calling number from being displayed on Caller ID equipment of the called party) - **not** "transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party" as recited in claim 1.

Therefore, Applicants submit that the combination of Stewart and Weiland fails to teach or suggest "transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party" as recited in claim 1.

**Second**, Applicants submit that claim 1 is nonobvious over the combination of Stewart and Weiland because there is no suggestion or motivation from the prior art as a whole for a person of ordinary skill to have combined or modified these references to realize the invention of claim 1. See MPEP § 2143 (stating that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings).

Applicants submit that Stewart actually teaches away from “transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party” as recited in claim 1. *See* Stewart, column 3, lines 4-21 (stating that the first information provider may use the received identification information to access demographic information from a database on the network to provide selected content information to the portable computing device 110 of the mobile user). Thus, Applicants respectfully disagree with the Examiner’s assertion that it would have been obvious to modify Stewart to include the calling-number blocking service triggered by the profile management codes taught by Weiland. Applicants note that MPEP § 2143.01 specifically states that (1) the prior art must suggest the desirability of the claimed invention and (2) the level of skill in the art **can not be relied upon** to provide the suggestion to combine references.

**Third**, Applicants submit that a § 103(a) rejection of claim 1 based on the combination of Stewart and Weiland would be a hindsight reconstruction, using Applicants’ claim as a template to reconstruct the method of providing an identity blocking service as set forth in claim 1 by picking and choosing isolated disclosures from the prior art. Such hindsight reconstruction is improper and impermissible under the law. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01.

Thus, for the reasons stated hereinabove, Applicants submit that claim 1 is nonobvious over the combination of Stewart and Weiland. Applicants further submit that claims 2-4, 7, 9-10 and 14-15, which depend from independent claim 1, are also nonobvious over the references of record. *See* MPEP §2143.03 (stating that if an independent claim is nonobvious under §103(a), then any claim depending therefrom is nonobvious).

Accordingly, Applicants respectfully request that the §103 rejections associated with claims 1-4, 7, 9-10 and 14-15 be withdrawn.

Claims 5-6, 8 and 11-12

Claims 5-6, 8 and 11-12 depend from claim 1. Applicants submit that claim 1 is nonobvious over Stewart in view of Weiland and Boyd because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 1. *See* MPEP § 2143 *id.* More specifically, Applicants submit that the cited references fail to teach or suggest, among other things, “transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party” as recited in claim 1.

As explained previously, the combination of Stewart and Weiland fails to teach or suggest this feature. Applicants also submit that Boyd fails to teach or suggest this feature. Indeed, the Office Action does not even rely on Boyd as teaching or suggesting this feature. Rather, the Office Action cites Boyd as teaching providing information about the identity of a user that is performed when a user signs up for a communication service that allows a user to operate a wireless communication device. Even if taken as true, Applicants submit that Boyd fails to remedy the defects of Stewart and Weiland with respect to claim 1.

Therefore, Applicants submit that claim 1 is nonobvious over the combination of Stewart,

Weiland and Boyd. *See* MPEP § 2143 *id.* Applicants further submit that claims 5-6, 8 and 11-12, which depend from claim 1, are also nonobvious over the combination of Stewart, Weiland and Boyd. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the §103(a) rejections associated with claims 5-6, 8 and 11-12 be withdrawn.

### Claim 13

Claim 13 depends from claim 1. Applicants submit that claim 1 is nonobvious over Stewart in view of Weiland and Hidary because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 1. *See* MPEP § 2143 *id.* More specifically, Applicants submit that the cited references fail to teach or suggest, among other things, “transferring the first information about the first location of the user to a third party without disclosing the identity of the user to the third party” as recited in claim 1.

As explained previously, the combination of Stewart and Weiland fails to teach or suggest this feature. Applicants also submit that Hidary fails to teach or suggest this feature. Indeed, the Office Action does not even rely on Hidary as teaching or suggesting this feature. Rather, the Office Action cites Hidary as teaching providing an emergency channel to an emergency service provider when a user requests emergency help. Even if taken as true, Applicants submit that Hidary fails to remedy the defects of Stewart and Weiland with respect to claim 1.

Therefore, Applicants submit that claim 1 is nonobvious over the combination of Stewart, Weiland and Hidary. *See* MPEP § 2143 *id.* Applicants further submit that claim 13, which depends from claim 1, is also nonobvious over the combination of Stewart, Weiland and Hidary. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the §103(a) rejection associated with claim 13 be withdrawn.

Claims 16-18 and 25

Applicants submit that independent claim 16 is nonobvious over Stewart in view of Weiland because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 1. *See* MPEP § 2143 *id.* More specifically, Applicants submit that the cited references fail to disclose, teach or suggest, among other things, “transmitting the information about the location of the user to a subscriber desirous of sending an advertisement to the wireless communication device, wherein the transmission of the information about the location of the user **excludes** disclosure of the identity of the user” as recited in claim 16.

For reasons similar to those set forth hereinabove with respect to claim 1, Applicants submit that the combination of Stewart and Weiland also fails to teach or suggest “transmitting the information about the location of the user to a subscriber desirous of sending an advertisement to the wireless communication device, wherein the transmission of the information about the location of the user **excludes** disclosure of the identity of the user” as recited in claim 16.

Thus, Applicants submit that claim 16 is nonobvious over the combination of Stewart and Weiland because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 16. Applicants further submit that claims 17-18 and 25, which depend from independent claim 16, are also nonobvious over the references of record. *See* MPEP §2143.03 *id.*

Accordingly, Applicants respectfully request that the §103 rejections associated with claims 16-18 and 25 be withdrawn.

Claims 19-23

Claims 19-23 depend from claim 16. Applicants submit that claim 16 is nonobvious over

Stewart in view of Weiland and Boyd because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 16. *See* MPEP § 2143 *id.* More specifically, Applicants submit that the cited references fail to teach or suggest, among other things, “transmitting the information about the location of the user to a subscriber desirous of sending an advertisement to the wireless communication device, wherein the transmission of the information about the location of the user **excludes** disclosure of the identity of the user” as recited in claim 16.

As explained previously, the combination of Stewart and Weiland fails to teach or suggest this feature. Applicants also submit that Boyd fails to teach or suggest this feature. Indeed, the Office Action does not even rely on Boyd as teaching or suggesting this feature. Rather, the Office Action cites Boyd as teaching providing information about the identity of a user that is performed when a user signs up for a communication service that allows a user to operate a wireless communication device. Even if taken as true, Applicants submit that Boyd fails to remedy the defects of Stewart and Weiland with respect to claim 16.

Therefore, Applicants submit that claim 16 is nonobvious over the combination of Stewart, Weiland and Boyd. *See* MPEP § 2143 *id.* Applicants further submit that claims 19-23, which depend from claim 16, are also nonobvious over the combination of Stewart, Weiland and Boyd. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the §103(a) rejections associated with claims 19-23 be withdrawn.

#### Claim 24

Claim 24 depends from claim 16. Applicants submit that claim 16 is nonobvious over Stewart in view of Weiland and Hidary because the cited references, either alone or in combination, fail to teach or suggest each and every element of claim 16. *See* MPEP § 2143 *id.* More specifically,

Applicants submit that the cited references fail to teach or suggest, among other things, “transmitting the information about the location of the user to a subscriber desirous of sending an advertisement to the wireless communication device, wherein the transmission of the information about the location of the user **excludes** disclosure of the identity of the user” as recited in claim 16.

As explained previously, the combination of Stewart and Weiland fails to teach or suggest this feature. Applicants also submit that Hidary fails to teach or suggest this feature. Indeed, the Office Action does not even rely on Hidary as teaching or suggesting this feature. Rather, the Office Action cites Hidary as teaching providing an emergency channel to an emergency service provider when a user requests emergency help. Even if taken as true, Applicants submit that Hidary fails to remedy the defects of Stewart and Weiland with respect to claim 16.

Therefore, Applicants submit that claim 16 is nonobvious over the combination of Stewart, Weiland and Hidary. *See* MPEP § 2143 *id.* Applicants further submit that claim 24, which depends from claim 16, is also nonobvious over the combination of Stewart, Weiland and Hidary. *See* MPEP § 2143.03 *id.* Accordingly, Applicants respectfully request that the §103(a) rejection associated with claim 24 be withdrawn.



CONCLUSION

Applicants respectfully request a Notice Of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,

Date: January 28, 2004

Robert A. Muha  
Robert A. Muha  
Reg. No. 44,249

KIRKPATRICK & LOCKHART, LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222

Telephone: (412) 355-8244  
Facsimile: (412) 355-6501  
E-mail: [rmuha@kl.com](mailto:rmuha@kl.com)